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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,595	01/16/2004	Michael Gerard Kelly	AM100053-P1	8698

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EXAMINER

HABTE, KAHSAI

ART UNIT PAPER NUMBER

1624

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,595

Applicant(s)

KELLY ET AL.

Examiner

Kahsay Habte, Ph. D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 9-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 14-18 and 20 is/are rejected.
- 7) ☒ Claim(s) 8 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/30/05 & 1/16/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-20 are pending in this application.

Election/Restriction

2. Applicant's election with traverse of Group IV, Claims 1-8 and 14-20 in a paper dated 5/20/2005 is acknowledged. The traversal is on the ground(s) that "the claimed subject matter resulted from the same inventive effort....method claims of group VI are specifically limited to the compounds of groups I-V and don not apply to other compounds or materially different product". As set in the restriction requirement, the method claims in Group VI would be rejoined once the conditions are met.

Applicants also argue that coexamination of the additional groups would not require an additional burden of search, since the compounds of claim 1 contain a common core structure having one or two nitrogen atoms. The examiner disagrees with applicant's argument. The groups are different one from the other, since the heterocyclic ring that is attached to the benzo ring of the "indole ring system" is different one from the other. The size of the ring and the nature of the heteroatoms of the heterocyclic ring that is attached to the "indole ring system" is different one from the other as set forth in the restriction requirement. Note that the restriction is not based on the "indole ring system", but based on the ring attached to the "indole ring system". The "indole ring system" is not a common core structure shared by all groups, since X and Y are variables. A piperazine ring attached to an indole ring is different from a piperazine ring attached to a benzimidazole ring (X = N, Y = C). Coexamination of each of the

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additional groups would require search of subclasses unnecessary for the examination of the elected claims. For example, the search for the invention of Group I would include search of subclass 548/311.7 and 312.1, the search for the invention of Group II would include search of subclass 546/199 and 546/201 and the search for the invention of Group III would include search of subclass 540/575, 540/602 and 540/603. Therefore, coexamination of each of these additional inventions (i.e. Groups I-III and V) would require a serious additional burden of search.

The requirement is still deemed proper and is therefore made FINAL.

3. The claims are drawn to multiple inventions for reasons set forth in the restriction requirement. The claims are examined only to the extent that they read on the elected invention. Cancellation of the non-elected subject matter is recommended in response to this Office Action.

Information Disclosure Statement

4. Applicant's Information Disclosure Statement, filed on 1/16/2004 and 3/30/2005 has been acknowledged. Please refer to Applicant's copies of the 1449 submitted herewith.

Claim Objections

5. Claims 1, 14 and 20 are objected to because of the following informalities: the term "C₁-C₆alkynyl" for the definition of variable R¹ is misspelled incorrectly. It should

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read as "C₂-C₆alkynyl". Note that C1 can't make an alkynyl group. Applicants have also to fix "C₁-C₆alkenyl" to "C₂-C₆alkenyl".

Objection

6. Claims 8 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7, 14-18 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1, 7, 14, 16 and 20, the phrase "optionally substituted" is indefinite. In the absence of the specific moieties intended to effectuate modification by the "substitution" or attachment to the chemical core claimed, the term "substituted" renders the claims in which it appears indefinite in all occurrences wherein applicants fails to articulate by chemical name, structural formula or sufficiently distinct functional language, the particular moieties applicants

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regards as those which will facilitate substitution, requisite to identifying the composition of matter claimed.

Conclusion


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson (Acting SPE) can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kahsay Habte, Ph. D.
Examiner
Art Unit 1624



Mark L. Berch
Primary Examiner
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